

## REMARKS

In view of the foregoing amendments and the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the rejections.

### **Improper Finality of Office Action**

The finality of the Office Action is improper because the rejection of claims 7-11 under 35 USC § 101 is a new rejection. Claims 7-11 have been amended in the October 30, 2008 Amendment to recite additional steps. The new rejection of claims 7-11 under 35 USC § 101 is not necessitated by such claim amendments.

MPEP 706.07(a) provides that a second or any subsequent action on the merits shall be final, except where the Office introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement (IDS) filed during the period set forth in 37 C.F.R. 197(c), e.g., before a final Office Action is issued.

Since the rejection under 35 USC § 101 in the present Office Action is (1) not necessitated by any claim amendments presented by Applicant, and (2) not based on any information presented in an Information Disclosure Statement, the finality of the present Office Action is improper. By introducing a new rejection in the present Office Action that is not necessitated by claim amendments or information presented in an IDS, the finality of the present Office Action does not provide Applicant an adequate opportunity to respond to the new grounds of rejection, and thus is prejudicial to the Applicant.

For at least the foregoing reasons, Applicant respectfully requests that the improper finality of the present Office Action be withdrawn.

**Response to Claim Rejection under 35 USC § 101**

Claims 7-11 have been rejected under 35 USC § 101 as allegedly not falling within one of the four statutory categories of invention.

For clarification, claim 7 has been amended to recite a compression method displaying step for displaying on a display for each region one or more compression methods for the compression process to be performed in accordance with a type of the region from among a plurality of compression methods. Claims 8-11 have been amended to recite a compression process mode displaying step for displaying a plurality of compression process modes on a display. The subject matters in claims 7-11 are tied to another statutory category.

For at least the foregoing reasons, Applicant respectfully requests that the rejection of claims 7-11 under 35 USC § 101 be withdrawn.

**Response to Claim Rejection under 35 USC § 103(a)**

Claims 1 – 16 and 40 have been rejected under 35 USC § 103(a) as allegedly being unpatentable over US Patent 5,949,968, hereinafter Gentile, in view of the article "Mixed Raster Content...", hereinafter Queiroz, JP 05-110737, hereinafter Hiroshi, and US Patent Publication 2003/0132960, hereinafter Litwiller.

Claim 1 recites that the selection unit displays one or more compression methods on the display for each region, enabling a user to select one of the plurality of compression methods in accordance with a type of the region from among the plurality of compression methods.

Gentile, Queiroz, Hiroshi and Litwiller, whether considered individually or in combination, do not disclose the combination of claim 1 that includes the above-recited features.

As acknowledged by the Examiner, Gentile does not disclose a selection unit which displays one or more compression methods on the display. Therefore, Gentile could not possibly teach or suggest the combination of claim 1 that includes a selection unit which displays one or more compression methods on the display for each region.

Queiroz and Hiroshi, relied upon for their alleged teaching of encoding methods for text, graphic and photograph, likewise, do not have any mention of a selection unit which displays one or more compression methods on the display for each region.

Litwiller relates to modifying a message prior to sending the message to a receiver. In Litwiller, a display unit displays possible compression parameter choices including MH, MR, MMR and JBIG, for the entire message, and the user makes the choice by touching the corresponding portion of the touch-sensitive display.

Although Litwiller may teach a display which displays possible compression parameter choices, such displayed possible compression parameter choices are for the entire message. Litwiller does not teach or suggest the combination of claim 1 that includes a selection unit which displays one or more compression methods on the display for each region.

Claim 1 further recites that the selection unit displays only compression methods from compression methods in the plurality of compression methods that are designated for the type of regions. As discussed in the October 30, 2008

Amendment, according to exemplary embodiment of the claimed combination, even if the user does not have particular knowledge regarding compression methods, the user can select a compression method for each region from among a plurality of compression methods suitable for each type of region.

Since none of the applied references teaches the claimed combination that includes the compression method selection unit that displays a plurality of compression methods on the display for each region, it is impossible for the applied references to teach or suggest the combination of claim 1 that includes the compression method selection unit that displays only compression methods from compression methods in the plurality of compression methods that are designated for the type of regions.

Accordingly, claim 1 of the present application is patentable over the applied prior art. Applicant reserves the right to challenge the Examiner's alleged motivation for combining the four references at a later time if appropriate and necessary.

With regard to claims 2-5, the claims have been amended to recite a display and a compression process mode setting unit, said compression process mode setting unit displays a plurality of compression process modes on the display, enabling a user to select one of the plurality of compression process modes. Since finality of the present Office Action is improper, entry and consideration of such claim amendments are respectfully requested.

The Examiner relies upon a consultant in Gentile as alleged teaching of the claimed compression process mode setting unit. Applicant respectfully disagrees.

Although Gentile may disclose that compression algorithms are selected by a consultant, the reference does not have any mention of a display on which

compression process modes are displayed. In Gentile, the consultant merely affects selection of compression algorithms based on compression factors. However, Gentile does not disclose displaying the compression algorithms or the compression factors. Therefore, Gentile does not teach or suggest the combinations of claims 2-5 that include a compression process mode setting unit, said compression process mode setting unit displays a plurality of compression process modes on the display, enabling a user to select one of the plurality of compression process modes.

Queiroz and Hiroshi, relied upon for their alleged teaching of encoding methods for text, graphic and photograph, likewise, do not teach or suggest the claimed combination including a compression process mode setting unit.

Although Litwiller may teach a display which displays possible compression parameter choices, the cited reference does not have any mention of compression process modes or selection thereof. Therefore, Litwiller does not teach or suggest the claimed combination including a compression process mode setting unit.

Accordingly, claims 2-5 of the present application are patentable over the applied prior art. Applicant reserves the right to challenge the Examiner's alleged motivation for combining the four references at a later time if appropriate and necessary.

Claims 6 and 7 include distinguishing features analogous to claim 1, and are thus also patentable over the applied art.

Claims 8 - 11 include distinguishing features analogous to claim 2 - 5, and are thus also patentable over the applied art.

Claims 12 - 16 recite computer-readable mediums encoded with computer-readable instructions. The claims are comparable to claims 7 - 11, and are thus also patentable over the applied art.

Claim 40 is comparable to claim 5, and is thus also patentable over the applied art.

The Examiner is respectfully requested to reconsider and withdraw the objections and rejections. In the event that there are any questions concerning the amendments, or the application in general, the Examiner is urged to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

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